Appl. No. 10/052,067
Amdt. dated December 21, 2005
Reply to Office Action of October 27, 2005

REMARKS

Claims 1 to 5, 7 to 15, and 17 to 23 were pending in the application at the time of final examination. Claims 1 to 5, 7 to 15, and 17 to 23 stand rejected as obvious.

Claims 1 to 5, 7 to 15, and 17 to 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Patent Application No. 2001/0034788, hereinafter referred to as McTernan, in view of U.S. Patent No. 6,766,376, hereinafter referred to as Price.

Applicant respectfully traverses the obviousness. Applicant first notes that the burden is on the Examiner to establish a prima facie obviousness rejection that complies with the standards of the MPEP. As noted more completely, below, the rejection fails to establish a prima facia obviousness rejection.

Applicant notes that the rejection paraphrases paragraph [0018] and then concludes "Price cures the deficiency of McTernan by shifting was is expected of the client to the server." This clearly mischaracterizes McTernan.

Paragraphs [0018] and [0019] of McTernan are identifying a need that is solved by the invention of McTernan and not defining a deficiency of McTernan. This is clear by simply reading paragraph [0020] of McTernan, which stated "It is an object of the present invention to solve the problems described above in existing content delivery systems." The problems described above included paragraph [0018].

Accordingly, one reading McTernan in view of paragraph [0018] would conclude that McTernan solved the problem and would look no further. Applicant's claim language cannot be used as a basis for ignoring the teaching of McTernan that clearly and unambiguously stated that the issues of Paragraph [0018] were solved. The rejection has cited no teaching that McTernan failed to adequately address the problems outlined in

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Paragraph [0018]. Thus, when McTernan is considered as a whole, the is no reason that would of skill in the art would look for ways to modify McTernan. The MPEP directs:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, III, 8th Ed. Rev. 3, pg. 2100-137.

There has been no citation to any reason in either reference suggesting that further modification of McTernan was desirable. This alone is sufficient to overcome the rejection.

Moreover, Price describes a system where a unique connection is established for each user. Specifically,

> maintaining a pointer 24a through 24n into the buffer, one for each user computer indicating the last media data element that has been sent to that user, thus indicating the next element or elements to be sent; and, once the FIFO buffer is full, deleting the oldest data element in the buffer as each new data element is received

Price, col. 9, lines 7 to 12.

Price maintains a pointer for each connection, and transfers data based on the location of that pointer. If the connections were not unique, there would be no need to maintain a pointer for each user computer. For example, the rejection has not cited any teaching of McTernan maintaining such a pointer.

Fig. 3 of Price is describing how data elements in the buffer are transmitted to a buffer in a user computer for that particular user. The transmission is done while the connection is open. Price fails to provide any rationale for using the process after the connection is closed and in fact would not work in such a situation. Thus, the rejection simply extracts

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a piece of the reference while ignoring the context in which the piece is used. This is an improper form of analysis.

Finally, Price effectively described unicasting because the server establishes a unique connection for each user and transmits data over the connection based upon the location of the pointer for that user computer. The transmission to that computer is associated with a particular user and the connection to that user.

With respect to unicasting, McTernan stated:

> is referred to as the unicast method of transmission, whereby a sender establishes a unique connection with each recipient. . . . This method, however, is not the most efficient means for distributing information simultaneously to multiple recipients. The transmission method that best facilitates broadcasting to many recipients simultaneously is multicasting.

McTernan, paragraph [0015].

Thus, the rejection would modify the multicasting technique of McTernan by modifying it to use the unicasting technique of Price that would maintain a pointer for each user and require a unique connection according to Price. This is exactly what McTernan was designed to avoid by implementing multicasting. Accordingly, the primary reference, when considered as a whole, teaches away from the proposed modification.

Further, changing the multicast system of McTernan into a unicast system by including the unicast method of transmission as shown in Fig. 3 of Price would make McTernan unsuitable for its intended purpose, multicasting. Accordingly, the combination of references is not appropriate.

In particular,

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make

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the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

MPEP § 2143.01, V, 8th Ed. Rev. 3, pg. 2100-137. Thus, according to the MPEP, the combination of references is inappropriate for yet another reasons.

McTernan does not close the broadcast loop. McTernan taught:

> . . . The Looping Data Sender 210 takes each packet 212 and transmits it by way of an integrated or external network adapter 216 to clients 220 via a network 218. After the final packet 212 in the sequence is received and transmitted, the Looping Data Sender 210 begins re-transmitting the packets starting with the first packet in the sequence. In this manner, the Looping Data Sender continually "loops" through the transmission of the packets,

McTernan, paragraph [0037].

Accordingly, when the connection is closed, the client has already received the entire loop of packets. Thus, the rejection requires further modifications to McTernan in that the server must first determine when the entire loop of packets is ready for a particular client based upon when the client connected, close the connection, and the implement the process of Price according to the rejection. This requires the server not only to be modified in multiple ways that are suggested in neither reference, but also increases the processing load, data storage requirements etc. on the server. As is well recognized in the art, increasing such requirements on a server can bring the server to a halt. The rejection has cited no teaching or suggestion that Price is even concerned with this issue, and McTernan teaches a way to avoid the issue. Accordingly, the combination is not well-founded, because the rejection has not established that McTernan would still work when modified as suggested in the rejection. Moreover, in view of these problems, one of skill would not shift work from the client to

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the server without determining the server could in fact accommodate the additional workload.

Since the rejection fails to comply with multiple requirements of the MPEP, the rejection is not well found and does not establish a prima facie obviousness rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 1, 11, 21, 22, and 23.

Each of Claims 2 to 5, 7 to 10, 12 to 15 and 17 to 20 distinguish over McTernan for at least the same reason as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each Claims 2 to 5, 7 to 10, 12 to 15 and 17 to 20,

Claims 1 to 5, 7 to 15, and 17 to 23 remain in the application. Claims 6 and 16 were canceled previously. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. 571-273-8300, on December 21, 2005.

Rivkah Young

December 21, 2005
Date of Signature

Respectfully submitted,

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